

**UNITED STATES DEPARTMENT OF COMMERCE****Patent and Trademark Office**

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/544,212 10/17/95 RUSSO

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EXAMINER

BRUNSMAN, D

ART UNIT

PAPER NUMBER

1108

DATE MAILED:

03/03/97

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

08/544,212

Applicant(s)

Russo et al

Examiner

David M. Brunzman

Group Art Unit

1108



☒ Responsive to communication(s) filed on 27 November 1996 as well as protests filed 27 June 1996 and 29 Janua.

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-55 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-55 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☒ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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The reissue oath or declaration filed with this application is defective because it fails to particularly specify the errors and/or how the errors relied upon arose or occurred as required under 37 CFR 1.175(a)(5). Included are inadvertent errors in conduct, i.e., actions taken by the applicant, the attorney or others, before the original patent issued, which are alleged to be the cause of the actual errors in the patent. This includes how and when the errors in conduct arose or occurred, as well as how and when these errors were discovered. Applicant's attention is directed to *Hewlett-Packard v. Bausch & Lomb*, 11 USPQ2d 1750, 1758 (Fed. Cir. 1989). The oath or declaration fails to specify specifically *how* the errors occurred. The reissue oath sets forth that the error was a misunderstanding between counsel and inventors. This does not specify how the error occurred, especially in view of the original filing which contained only claims to the composition and the sworn statement that "the specification, including the claims,[was] reviewed and understood" by the undersigned applicants.

Claims 28-55 are rejected as being based upon a defective reissue declaration under 35 U.S.C. § 251. See 37 C.F.R. § 1.175.

The *In re Rowand*, 187 USPQ 487, decision is instructive to the instant prosecution. It is set forth that determination of compliance with 35 U.S.C. § 251 should be decided first in a reissue application before other issues of patentability must be ruled upon. Comment on the protests filed 27 June 1996 and 29 January 1997 by Donald A. Schurr will initially be limited to compliance issues.

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Claims 28-55 are rejected under 35 U.S.C. § 251. The *Rowand* decision addresses the propriety of a reissue application having claims to both product and process where restriction was required between product and process in the original application. A reissue applicant may not "recapture" the subject matter withheld by restriction in the original application in a reissue application. Failure to timely file a division application is not considered an "error" subject to correction by reissue. The reissue claims must be drawn to the coating composition to which the patented claims were limited. While the original application was the US national stage of a PCT application and did not contain a restriction requirement itself, the grandparent applications (07/814,352 and 07/814,366) included restrictions between coating composition, process of coating and the article made by that were ultimately acquiesced to by applicants.

Claims 28-55 are rejected under 35 U.S.C. § 251. The original application contained claims to a coating composition wherein the organometallic portion contained an organotin compound and an organosilicon compound. These claims were rejected as being unsupported by the original specification in that only certain species of organosilicon were enabled. In response to this rejection applicant limited the claims to compositions wherein the organosilicon compound was limited to the species recited in patented claim 1. Instant claims 33-55 expand the scope of the invention to include any organometallic compound including those specifically included in the original rejection. Clearly, if the coating composition to be used is not enabled, claims to products made therefrom cannot be enabled. "The recapture rule bars the patentee from acquiring, though reissue claims that are of the *same or broader*

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scope than those claims that were canceled from the original application." *Ball Corp. v. United States*, 221 USPQ 289, 295; see also *In re Willingham*, 127 USPQ 211; *In re Richman*, 161 USPQ 359 and; *In re Wadlinger, Kerr and Rosinski*, 181 USPQ 826. Reissued claims must include limitations made in the original application to overcome the rejection therein. See, *Mentor v. Coloplast*, 27 USPQ2d 1521, 1524. Claims 28-32 have been amended to limit the silicon oxide precursor to the materials recited in the patented claims. Claims 28-32 are broader than claims originally canceled from the specification in that they are drawn to gaseous coating compositions containing a metal oxide precursor not limited to tin oxide (as the patented claims are.) Regardless of the scope of inventions the original disclosure may support, that which was *intended to have been claimed*, may only comprise the extent of material added to the claims of a reissue. Only the objective evidence set forth in the prosecution history of the patented claims can be relied upon to determine what was intended to have been claimed. *Ball Corp. v. United States*, 221 USPQ 289. In the original application, the lack of disclosure teaching one of ordinary skill in the art the reaction conditions necessary to use any metal oxide precursor other than a tin oxide precursor; the claims as amended to place the application in condition for allowance and; the limitations of the original abstract and the claims, as filed, which were "reviewed and understood" by applicants present compelling evidence that the invention that was intended to have been claimed is limited to the claims ultimately patented.

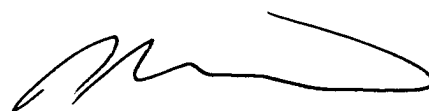
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Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for response to this final action is set to expire **THREE MONTHS** from the date of this action. In the event a first response is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for response expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David M. Brunzman whose telephone number is (703) 308-0661.

DMB  
March 3, 1997



David M. Brunzman  
Primary Examiner  
Group 1100